

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering this application and for indicating that the drawings filed on September 3, 2007 are accepted.

**Disposition of Claims**

Claims 1-33 are pending in this application. Claims 1, 14, 21, 27, 30, and 31 are independent. By way of this reply, claims 1-13 are canceled without prejudice or disclaimer. The remaining claims depend, directly or indirectly, from claims 14, 21, 27, and 31.

**Rejection(s) under 35 U.S.C § 112**

Claims 1-13 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. Claims 1-13 are canceled. Thus, the rejection is now moot with respect to these claims. Accordingly, withdrawal of this rejection is requested.

**Rejection(s) under 35 U.S.C § 101**

Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 1 is canceled. Thus, the rejection is now moot with respect to claim 1. Accordingly, withdrawal of this rejection is requested.

**Rejection(s) under 35 U.S.C § 102**

Claim 1 is rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 7,117,502 (hereinafter "Harris"). Claim 1 is canceled. Thus, the rejection is now moot with respect to claim 1. Accordingly, withdrawal of this rejection is requested.

**Rejection(s) under 35 U.S.C § 103**

Claims 2-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Harris in view of “Skip Lists: A Probabilistic Alternative to Balanced Trees” by William Pugh (hereinafter “Pugh”). Claims 2-13 are canceled by way of this reply. Thus, this rejection is now moot with respect to the canceled claims.

Claims 14-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pugh in view of Harris. This rejection is respectfully traversed.

Applicants assert that the use of Harris to reject these claims under 103(a) is improper under 35 U.S.C. § 103(c). Subject matter developed by another person, which qualifies as prior art only under one or more of 35 U.S.C. § 102 (e), (f), and (g) does not preclude patentability under 35 U.S.C. § 103 “if the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” 35 U.S.C. § 103(c).


Harris was granted under on October 3, 2006, and the present application has not been granted, thus making Harris prior art under 35 U.S.C. § 102(e)(2). Further, Applicants’ patent application and Harris were, at the time Applicants’ invention was made, owned by, or subject to an obligation of assignment to Sun Microsystems, Inc. Harris, as indicated on the face of the patent, and Applicants’ patent application, by way of an Assignment recorded at Reel/Frame 014483/0341, are assigned to Sun Microsystems, Inc. A copy of the Notice of Recordation of Assignment for Applicants’ application and the face of the patent for Harris are enclosed with this reply. Accordingly, the use of Harris in an obviousness rejection of claims 14-33 is improper under 35 U.S.C. § 103(c), and withdrawal of this rejection is respectfully requested.

**Conclusion**

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 33226/972001; P7982).

Dated: April 10, 2007

Respectfully submitted,

By 

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Attachments (Assignment)  
(1st Page of Patent No. 7,117,502)

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*Dwo*

APRIL 07, 2004

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APR 15 2004

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RECORDATION DATE: 09/03/2003

REEL/FRAME: 014483/0341  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:  
MARTIN, PAUL A.

DOC DATE: 08/27/2003

ASSIGNOR:  
STEELE, GUY L., JR.

DOC DATE: 08/27/2003

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DOC DATE: 09/02/2003

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DOC DATE: 08/27/2003

014483/0341 PAGE 2

ASSIGNEE:

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SERIAL NUMBER: 10653828

PATENT NUMBER:

FILING DATE: 09/03/2003

ISSUE DATE:

MAURICE CARTER, PARALEGAL  
ASSIGNMENT DIVISION  
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09-16-2003



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Patent and Trademark Office

To the Honorable Commissioner of Patent

102553013

and original documents or copy thereof.

## 1. Name of conveying party(ies):

Paul A. Martin; Guy L. Steele Jr.; Nir N. Shavit; Steven K. Heller;  
Mark S. Moir and Victor M. Luchangco

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

## 2. Name and address of receiving party(ies):

Name: Sun Microsystems, Inc.Internal Address: 4150 Network CircleStreet Address: 4150 Network CircleCity/State/Zip: Santa Clara, CA 95054Additional name(s) & address(es) attached? ☐ Yes ☒ No

## 3. Nature of Conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other: \_\_\_\_\_Execution Date(s): 8/27/03, 8/27/03, 9/2/03, 9/2/03, 8/27/03  
and 8/27/03 respectively

## 4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: 8/27/03, 8/27/03,  
9/2/03, 9/2/03, 8/27/03 and 8/27/03 respectively

A. Patent Application No.:

B. Patent No.:

10/653828

Additional numbers attached? ☐ Yes ☒ No

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: David W. O'BrienInternal Address: Zagorin, O'Brien & Graham, L.L.P.Street Address: 401 West 15<sup>th</sup> Street, Suite 870City/State/Zip: Austin, TX 787016. Total number of applications and patents involved: 1

09/05/2003 HTECKLU1 00000025 10653828

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*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy  
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9/3/03

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## ASSIGNMENT OF INVENTION

For good and valuable consideration, the receipt of which is hereby acknowledged,  
I, an ASSIGNOR named below,

Paul A. Martin of Arlington, MA  
Guy L. Steele Jr. of Lexington, MA  
Nir N. Shavit of Cambridge, MA  
Steven K. Heller of Acton, MA  
Mark S. Moir of Somerville, MA  
Victor M. Luchangco of Arlington, MA

hereby sell, assign and transfer to

ASSIGNEE: Sun Microsystems, Inc., a Delaware corporation, having a principal  
place of business at 4150 Network Circle, Santa Clara, CA 95054,

its successors, assigns and legal representatives, my entire right, title and interest throughout  
the world, including all rights to claim priority, in and to the invention(s) disclosed in:

- ☒ U.S. Patent Application executed on or about the date of this Assignment,  
☐ U.S. Patent Application executed on \_\_\_\_\_, or  
☐ U.S. Provisional Application  
☐ U.S. Application No.: \_\_\_\_\_, filed on \_\_\_\_\_  
☐ International Application No.: PCT/\_\_\_\_\_, filed on \_\_\_\_\_

ENTITLED: **SHARED SKIP-LIST DATA STRUCTURE  
SYNCHRONIZED USING DOUBLE-COMPARE-AND-  
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INVENTOR(S): Paul A. Martin, Guy L. Steele Jr., Nir N. Shavit, Steven K. Heller,  
Mark S. Moir and Victor M. Luchangco

including without limitation, my entire right, title and interest in and to any and all United  
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To comply with 37 C.F.R. § 3.21 for recording this Assignment, I authorize and request that  
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(\_\_\_\_\_/\_\_\_\_\_, filed \_\_\_\_\_) when they become known.

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claim all rights of priority without further authorization from me.

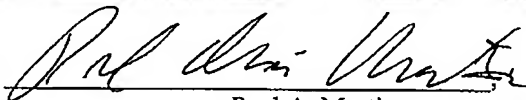
I agree to execute any and all papers useful in connection with any and all United States and  
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ASSIGNMENT OF INVENTION

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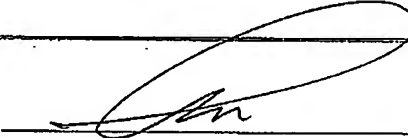
Paul A. Martin

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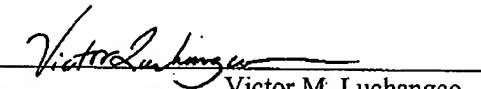
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